

Remarks

The Applicant respectfully traverses the instant restriction requirement and herein requests reconsideration of the same by the Examiner. The Examiner has indicated that:

[t]he inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature common to all of the groups cannot be considered a patentable advance over the art given that said feature, namely the sunscreen preparation or other skin preparation, is old. For example, US Patent 5,705,146 discloses sunscreen compositions having an SPF in the UVA range (see col. 3, lines 10-15). Additionally, US Patent 5,968,485 discloses sunscreen compositions having a desired level sun protection factor and a desired level of UVA protection, citing that "SPF" is a commonly used measure of photoprotection of a sunscreen (see col. 4, line 58 - col. 5, line 10).

Contrary to the Examiner's implication, all of the claims in Groups I-III (as identified by the Examiner) do in fact relate to a single general inventive concept, as those claims do include many common technical features beyond those mentioned by the Examiner.

For example, regarding the claims of Groups I and II, claim 9 (Group II) is drawn to an apparatus that could perform the method steps of claim 1 (Group I). More specifically: claim 1 includes the method step of "irradiating a sample of human skin or of an effective substitute therefore...with UV radiation comprising UVA wavelengths" while claim 9 (Group II) includes "at least one sample of human skin or of an effective substitute therefore... [and] a source of UV radiation comprising UVA wavelengths"; in claim 1 the skin is "shielded with the sunscreen composition or other skin preparation to be tested" while claim 9 includes a "means for shielding a skin sample with the

sunscreen composition or other skin preparation to be tested"; claim 1 includes the step of "determining by electron spin resonance (ESR) spectroscopy the level of induced production of ascorbate radical in the shielded skin" while claim 9 includes a "means for determining by electron spin resonance (ESR) spectroscopy the level of induced production of ascorbate or other measureable radical in a skin sample on exposure of the skin to the UV radiation"; and claim 1 includes the step of "determining a quantitative measure of the effectiveness of the sunscreen composition in reducing the exposure of human skin to UVA radiation by comparison of the said level of ascorbate radical production in the shielded skin with the level of ascorbate radical production induced in reference skin under substantially quantitatively comparable conditions" while claim 9 includes "means for determining a quantitative measure of the effectiveness of the sunscreen composition or other skin preparation in reducing the exposure of human skin to UVA radiation by comparison of the level of ascorbate or other measureable radical production in the shielded skin with the level of ascorbate or other measureable radical production induced in reference skin under substantially quantitatively comparable conditions".

Furthermore, regarding the claims of Group III, claims 13 and 14 include all of the limitations recited in claim 12, which is included in Group I identified by the Examiner. As such, all of the technical features of claim 12 (Group I) must correspond to technical features of claims 13 and 14 (Group III).

In light of the foregoing, the Applicant respectfully requests that the instant restriction requirement be withdrawn.

INVENTOR: HAYWOOD et al.
Serial No. 10/533,617

Reconsideration of the application respectfully is requested. The foregoing election and remarks are believed to be responsive to every matter raised in the office action. If, however, some matter has been overlooked, an opportunity to correct the oversight would be appreciated.

Respectfully submitted,



Bryan P. Stanley
Patent Office Reg. No. 44,352
SONNENSCHN NATH & ROSENTHAL LLP
PO Box #061080
Wacker Drive Station
Sears Tower
Chicago, IL 60606-1080
Telephone: (816) 460-2410
Facsimile: (816) 531-7545

Attorneys for Applicant